

REMARKS

The above listing of the claims shows the claims pending in the present application following entry of the amendment mailed on 10/19/05 which was submitted with the RCE in filed in October 2005.

The 1-12-06 Office Action issued in connection with the present application states that 10/19/05 amendment filed in connection with the present application was not fully responsive because it did "not include arguments pointing out specific distinctions believed to render that the added new claim(s), 39-42, are patentable over the applied references." 1-12-06 Office Action, p. 2.

It is respectfully submitted that the claims 39-42 which were added in the 10/19/05 Amendment are dependent claims which depend from independent claim 38. Claim 38 was amended in the 10/19/05 Amendment, and a detailed discussion was provided specifying specific distinctions between the amended claim 38 and the references which were referred to as the basis for the previous rejection of claim 38. Given that claims 39-42 depend from claim 38 it is respectfully submitted that these dependent claims would be patentable for at least the same reasons as claim 38.

However, in order to further the prosecution of the pending claims in this matter additional discussion will be provided herein to further focus the issues in this case, and to highlight the significant distinctions between the pending claims and the references which were the basis for the previous rejection of the claims in this matter.

The 9/13/05 Advisory Action, and the most recent Final Action (6/2/05 Office Action) in connection with this application, rejected all of the previously pending claims under 35 USC 103(a) as being unpatentable over US Patent 6,526,285 (Matsumoto et al.) in view of US Patent 5,920,848 (Schutzer).

This present response elaborates on two points, and it is respectfully submitted that each of these points compel a finding that the pending claims are patentable. The first point, discussed in detail below, is that the amendment to the claims provided for in the 10/19/05 Amendment adds an element to each of the claims which is not disclosed in, or suggested by, either the Matsumoto reference, or the Schutzer reference. The second point in the discussion provided for below is that as previously discussed there does not appear to be any teaching in either Matsumoto or Schutzer to combine their teachings, and further even if one were to

combine their teaching one would still not have arrived at the claims even as they existed prior to the 10/19/05 amendment to the claims.

The 10/19/05 Amendment

The 10/19/05 Amendment amended each of the pending independent claims, and added dependent claims 39-42, which depend from claim 38. As amended each of the independent claims includes elements which are directly related to limiting the number items being tracked in the data list. Specifically, each of the claims provides for limiting the number of items in the data list to a predetermined number. Each of the independent claims further provides an element which provides for displaying the running total of the number of items actually being tracked in the data list, and also displaying the predetermined number of items to which the data list is limited.

Specifically, as amended by the 10/19/05 Amendment, claim 1 recites in part:

“displaying a running total of the number of items in the data list, and displaying the predetermined number of items permitted in the data list;”

As amended by the 10/19/05 Amendment, claim 14, recites in part:

“the personal organizer device displays a running total of the number of items in the data list, and the predetermined number of items permitted in the data list;”

As amended by the 10/19/05 Amendment, claim 38, recites in part:

*“limiting the data list to a predetermined number of securities;
displaying a running total of the number of items in the data list, and displaying the predetermined number of items permitted in the data list;”*

It is respectfully submitted that the limiting of the data list to a predetermined number, in combination with displaying the predetermined number, and displaying the running total number of items being tracked provides a user with limitations in operation, and information which leads to efficient use of limited communication bandwidth. The user will be able to see if the actual number of items being tracked is approaching the predetermined limit and adjust the content of the data list accordingly. Indeed it is respectfully submitted that a careful review of both the

Matsumoto reference and Schutzer reference does not appear to provide any teaching regarding the limiting a data list to a predetermined number and then displaying the predetermined limit number and the actual number of items in the data list.

In addition to the operation of the data list, and the predetermined limit number for the data list, the claims provide for the use of multiple user tags such that items being tracked in the data list can be included in multiple different user defined categories of items. It is respectfully submitted that the unique combination of elements corresponding to the claims provides for (1) providing a data list (2) limiting the number of items to a predetermined number of items (3) providing multiple user tags so that an item being tracked will be displayed in multiple sublists (4) displaying the running total of the number of items being tracked, and (5) displaying the predetermined number which limits the total number of items which can be tracked in the data list. This combination of elements appears to be very different than anything disclosed in, or suggested by, any of the references.

Thus, in light of the above it is respectfully submitted that each of the independent claims 1, 14, and 38 are patentable over the references. It is further submitted that each of the dependent claims are patentable for at least the same reasons as their respective independent claim.

It is worth noting that claims 39-42 which were added in the 10/19/05 Office Action, are dependent claims which depend from claim 38. These dependent claims include all the limitations of the base independent claim 38 and as such it is respectfully submitted that these claims are patentable for at least the same reasons as the base independent claim 38. Further, claims 39 recites an additional element namely that the method further includes that:

“in response to a user selection displaying a master listing of the securities being tracked wherein the master listing includes securities having different user defined category tags”

Thus, claim 39 includes the limitations of claim 38 discussed above, and further the limitation of displaying a master listing of all the securities being tracked, and the master listing includes securities having different user defined category tags. It is respectfully submitted, that while it is believed that there is no showing of a motivation to combine the teaching of Matsumoto and Schutzer, as discussed below, even if one were to selectively combine different

elements of these references one would still not arrive the combination of elements recited by pending claim 38 or its dependent claim 39.

Dependent claim 40 recites an additional element namely that the method further includes:

displaying an edit icon and in response to a user selection of the edit icon, displaying an edit interface which allows a user to delete one of the user defined category tags.

Thus, claim 40 includes the limitations of claim 38 discussed above, and further the limitation of displaying an edit interface which allows a user to delete one of the user defined category tags. It is respectfully submitted, that while it is believed that there is no showing of a motivation to combine the teaching of Matsumoto and Schutzer, as discussed below, even if one were to selectively combine different elements of these references one would still not arrive the combination of elements recited by pending claim 38 or its dependent claim 40.

Dependent claim 41 recites an additional element namely that the method further includes that:

displaying an edit icon and in response to a user selection of the edit icon, displaying an edit interface which allows a user to rename a user defined category tag.

Thus, claim 41 includes the limitations of claim 38 discussed above, and further the limitation of in response to a user selection of an edit icon displaying an edit interface which allows a user to rename a user defined category tag. It is respectfully submitted, that while it is believed that there is no showing of a motivation to combine the teaching of Matsumoto and Schutzer, as discussed below, even if one were to selectively combine different elements of these references one would still not arrive the combination of elements recited by pending claim 38 or its dependent claim 41.

Dependent claim 42 recites an additional element namely that the method further includes:

displaying a quick access icon wherein in response to a user selection of the quick access icon, displaying a pull down menu which provides immediate navigation to five user selected screens.

Thus, claim 42 includes the limitations of claim 38 discussed above, and further the limitation of displaying a pull down menu which provides immediate navigation to five user selected screens in response to a user selecting a displayed quick access icon. It is respectfully submitted, that while it is believed that there is no showing of a motivation to combine the teaching of Matsumoto and Schutzer, as discussed below, even if one were to selectively combine different elements of these references one would still not arrive the combination of elements recited by pending claim 38 or its dependent claim 42.

The Combination of the Matsumoto reference and the Schutzer reference

The Final rejection (6/2/05 Office Action) recognized that Matsumoto failed to teach user defined category tags for tracking items. 6/2/05 Office Action, p. 3. However, the Office Action states that Schutzer teaches a system and method for tracking financial transactions, and using a “learning agent to monitor user-defined category of expenses, such as restaurant expenses where the learning agent act[s] as a monitor”. 6/2/05 Office Action, pp. 3-4. The Office Action goes on to state that it would have been obvious to combine the teaching of Matsumoto and Schutzer because both teach a system to monitor financial data. 6/2/05 Office Action, p. 4. Specifically, the 6/2/05 Office Action states, in part that it would have been obvious to modify the “teachings of Matsumoto and include user defined category tags as taught by Schutzer because both Matsumoto and Schutzer teach a system to monitor financial data based on categories so as the user receives specific information from a large pool of financial data.”

It is respectfully submitted that to establish a prima facie case of obviousness, among other things there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. See MPEP §2143. Indeed the Federal Circuit has visited the issue regarding obviousness on numerous occasions, for example:

The patent examination process centers on prior art and the analysis thereof. **When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness.** See, e.g., *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir.

2001) ("the central question is whether there is reason to combine [the] references," a question of fact drawing on the Graham factors).

In Re Sang Su Lee, 277 F. 3d 1338, 134-43 (emphasis added) (Fed. Cir. 2002). Thus, the question at hand is whether there some teaching which would suggest the combination of the Matsumoto and Schutzer.

Matsumoto et al. teach a system where a device referred to as telephone apparatus 101 can be used to obtain information through a communication line 201 from a data server 301. Matsumoto et al. col. 25:11-48. The information can be retrieved from the server by specifying an industry division, or by specifying a company stock code. Matsumoto et al. col. 25:41-48. The information then obtained can be stored in a memory of the telephone apparatus 101, and if the memory does not have enough capacity for all of the requested information, then a first part of the information requested is transmitted to the telephone device, and then in response to a scroll operation by the user, a second part of the information requested to the telephone device, and this second information apparently displaces the first part of information in the memory of the device. Matsumoto et al. col. 26:1-27.

In another alternative, Matsumoto contemplates a situation where the memory of the device has enough capacity to store more information than can be displayed on a display of the device, and the user can scroll through the information stored in the memory, or it appears that a user might be able to select viewing of a specific stock which is stored in memory. Matsumoto et al. col. 26:27-61. However, it is respectfully submitted that Matsumoto et al. does not appear to contain any teaching which suggests that a master list of data for items being tracked should be stored in the telephone device, and that one or more of the items being tracked will be supplied with multiple user defined category tags, such that the particular item would be displayed in multiple sublists, where the content of the sublists area controlled by the user defined category tags.

Schutzer teaches a system where computerized intelligent agents are provided which facilitate the integration of networks performing financial transactions with computerized methods for accounting. See e.g. Schutzer, Abstract. Schutzer discusses providing users with the capability to perform a wide variety of financial transactions on-line, including bill payment and stock purchases, and incorporated with these operations are intelligent agents which can trace and monitor the financial transactions and expenses. Schutzer col. 4:27-40.

One aspect of the teaching of Schutzer specifically referred to in the 6/2/05 Office Action (6/2/05 Office Action, p. 4) deals with various learning agents which can monitor user-defined categories of expenses such as restaurant expenses. Schutzer col. 12:46-60.

Given the teaching of Schutzer, and the teaching of Matsumoto, the question is then how do these two references, in combination suggest the systems and methods of the presently pending claims.

The 6/2/05 Office Action and the 9/13/05 Advisory Action recognize that "Matsumoto fails to teach user defined category tags." See e.g. Adv. Action, p. 2. The 6/2/05 Office Action and the Advisory Action, however, both go on to refer to Schutzer as teaching a learning agent which monitors a user-defined classification and tracking of financial expenses. In the 6/2/05 Office Action and the 9/13/05 Advisory Action, specific reference is made to three different passages from the Schutzer reference, and these passages are shown below for ease of reference:

It is an object of the present invention to provide an integrated financial transaction and financial accounting system with incorporated intelligent agents to meet the important financial needs of synthesizing, parsing, and **analyzing a user's complete financial picture**. It is a further object of the present invention to take a new approach to automated finances by combining automated performance on-line for a wide variety of financial transactions with automated monitoring and tracing of financial transactions, **as well as automated classification and tracking of financial expenses and under certain prespecified conditions taking action**.

Schutzer col. 3:24-35 (emphasis added).

This information system provides users with the capability to perform a wide variety of financial transactions on-line, including bill payment and stock purchases. Moreover, users combine this on-line performance of financial transactions with the tracing and monitoring of these financial transactions. Users also integrate their personal financial accounting with the financial transaction performance, monitoring, and tracing information provided by the system. Incorporated in the present invention are user interfaces with a plurality of intelligent agents, which are software applications that monitor, collect data, and generate user-specific advice, reports, or alerts. **The present invention also provides that intelligent agents trace and monitor financial transactions and financial expenses.**

Schutzer col. 4:27-40 (emphasis added).

Another feature of the intelligent agents that communicates directly with the user's account files includes the accounts merger feature 57, which generates a report for the user which tracks all of the user's expenses, income, investments, and tax information. This information generated is communicated 58 to the account files 45. In this way the accounts merger feature 57 serves to reconcile statements from the primary bank 40 or from the secondary bank 41 with respect to items such as payee, check or transaction number, expense category, and amount. Additionally the accounts merger gives the user a comprehensive picture of the user's financial history, projects numbers for the user's financial future, or generates user-specific reports on a subset of the user's financial data.

Schutzer col. 12:32-45 (emphasis added). It is respectfully submitted that a review of the above passages from Schutzer, as well as other teachings from Schutzer, shows that the user-defined expense categories provided for in Schutzer serve a very different purpose than any type of operation described in Matsumoto. Namely, whereas Matsumoto provides for predefined codes according to industry for example, which are used at central server for organizing data into preset groups (See e.g. Matsumoto col. 4; line 36-49 and col. 21: lines 57-61) the Schutzer reference is describing, in part, operations for user specific financial tracking information, such as tracking different types of user-defined expenses. It is respectfully submitted that there is no suggestion that one of skill in the art would be motivated to modify the teaching of Matsumoto so as to replace the predefined category information in Matsumoto with user defined category tags, merely because Schutzer suggests providing for user-defined categories for tracking expenses. Indeed, attempting to implement these types of user specific categories on the central server of Matsumoto would appear to be very incongruous with whole discussion, and operation, of the predefined categories as described in Matsumoto.

It is respectfully submitted that the general observation that Matsumoto and Schutzer deal with financial information does not support the proposition that the teaching of Schutzer would motivate one to modify Matsumoto to include user defined category tags for different securities which are being tracked in a watchlist. Further, even assuming arguendo that one were to make some modification of Matsumoto based on Schutzer it is respectfully submitted that one would still not arrive at a suggestion for operation which provides for, among other things, a master list of data of items being tracked and stored in a personal computing type device, and that one or more of the items being tracked will be supplied with multiple user defined category tags, such that the particular item would be displayed in multiple sublists, where the content of the sublists area controlled by the user defined category tags.

Further, as discussed above, with the additional limitations added to the claims by the 10/19/05 Amendment, it is respectfully submitted that the pending claims are further distinguishable over the references.

CONCLUSION

For the reasons set forth above, it is believed that all claims present in this application are patentably distinguished over the references. Therefore, reconsideration is respectfully requested, and it is requested that this application be passed to allowance.

The Commissioner is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 50-2001 under Order No. SCHB-3200. **A duplicate copy of the transmittal cover sheet attached to this Response is provided.**

Respectfully submitted,

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Dated: January 27, 2006

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